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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,078

02/06/2004

Lukas Eisermann

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09/27/2006

HAYNES AND BOONE, LLP

901 MAIN ST

SUITE 3100

DALLAS, TX 75202

EXAMINER

SWIGER III, JAMES L

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/774,078

Applicant(s)

EISERMANN ET AL.

Examiner

James L. Swiger

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3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/11/2004;11/26/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group III, claims 20-29 in the reply filed on 6/30/2006 is acknowledged.

Claims 1-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/30/2006.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winslow (US Patent 6,063,088) in view of Meulink et al. (US Patent 6,238,435). Winslow discloses a method of aligning a prosthetic device for insertion into an intervertebral space comprising providing an alignment instrument (see Fig. 2 and Col. 14, lines 30-45) with an anchoring device extending (110/112), and wherein the vertebral body is located adjacent the intervertebral space (see Fig. 13), aligning the instrument relative to the vertebrae (see Col. 14, line 39), driving the anchor into the vertebral body (see 110, Fig. 13, and Col. 6, lines 18-21).

Winslow discloses the claimed invention except for specifically a clamping assembly. Meulink et al. disclose a clamp assembly to operatively connect the

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alignment instrument and implantation device, towards a distal end (see Fig. 1, and clamping portion 36, that disposes the alignment device towards the distal [right] end). See Also, Col. 2, lines 38-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform the method of Winslow having at least a clamp assembly in view of Meulink et al. to better orient the alignment device relative to the prosthetic device.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Winslow '088 and Meulink et al. '435 as applied to claim 20 above, and further in view of Houfburg (US Patent 6,283,966). The combination of combination of Winslow '088 and Meulink et al. '435 disclose the above method except for specifically an instrument comprising a radiographic marker. Houfburg discloses the use of a radiographic marker so that the instrument can be used by a surgeon in combination with the appropriate electromagnetic radiation system (MRI, CT) see (Col. 8, lines 4-53). It would have been obvious to one having ordinary skill in the art at the time the invention was a made to perform the method of the combination of Winslow '088 and Meulink et al. '435 having at least a radiographic marker in view of Houfburg to better view the device during a surgical procedure.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Winslow '088 and Meulink et al. '435 as applied to claim 20 above, and further in view of Leone, Jr. (US Patent 6,302,890). The combination of Winslow '088 and Meulink et al. '435 disclose the claimed method except for a device having a bubble level. Leone, Jr. disclose an alignment assembly having at least a bubble level. Leone,

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Jr. disclose a bubble level to aid in aligning the device (see Col. 3, lines 49-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform the method of the combination of Winslow '088 and Meulink et al. '435 having at least a bubble level in view of Leone, Jr. to better align the device in use.

Claims 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Winslow '088 and Meulink et al. '435 as applied to claim 20 above, and further in view of Warner et al. (US Patent 5,643,286). The combination of Winslow '088 and Meulink et al. '435 disclose the claimed method except for at least two clamps that, respectively, are operatively connected to the alignment device and comprise the step of slidably moving along the alignment device to better position the prosthetic device adjacent to the intervertebral space. Warner et al. disclose at least two clamps (42 and 32) that are able to attach to an alignment device, or even a prosthesis holder that could be attached via an 'instrument holding member' and are able to be moved relative, respectively, to one another for adjusting the implantation device (see Col. 4, lines 16-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of Winslow '088 and Meulink et al. '435 having at least two clamps that can move the prosthesis holder and alignment device relative to one another in view of Warner et al. to better guide the device.

### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See pto-892.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 7/18/06

JLS



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER